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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/080,926	02/22/2002	Lin Zhi	015110.0096.UTL1	7786
36183	7590	07/06/2004	EXAMINER	
PAUL, HASTINGS, JANOFSKY & WALKER LLP P.O. BOX 919092 SAN DIEGO, CA 92191-9092			HUANG, EVELYN MEI	
			ART UNIT	PAPER NUMBER
			1625	
DATE MAILED: 07/06/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

10/080,926

Applicant(s)

ZHI ET AL.

Examiner

Evelyn Huang

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 21 June 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 21 June 2004. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☒ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see attachment.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

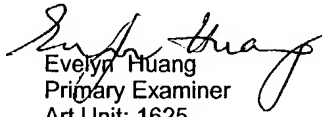
Claim(s) allowed: _____.

Claim(s) objected to: 40, 41.

Claim(s) rejected: 1-11, 14-39, 42-51 and 53-63.

Claim(s) withdrawn from consideration: 12, 13, 52 and 64-97.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____


Evelyn Huang
Primary Examiner
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Attachment to Advisory Action

1. Applicant requests rejoining claims 12, 13, and 52 since they comprises subject matter within the scope of Group III and should not be withdrawn. Applicant maintains that the examiner is required to search a reasonable number of species, if a generic or linking claim is found allowable. In the instant case, however, no generic claims are found allowable at the present time.

Furthermore, even if a generic claim were found allowable, such claims would not be rejoined after the final action, since it would require further consideration and new search.

However, claims 12, 13, 52, if amended to have the same scope as the elected formulae I-IV, would be rejoined upon allowance of the claims directed to formulae I-IV.

2. The cancellation of claims 18-22, 27-29, 53-54, 56 as in the amendment would obviate the rejection under 35 U.S.C. 112, second paragraph.

3. The objection to Claims 19, 22, 28 under 37 CFR 1.75 as being a substantial duplicate of claim 1 would be withdrawn upon the cancellation of these claims.

4. The rejection for Claims 1, 2, 4-11, 14-19, 21-39 under 35 U.S.C. 102(b) as being anticipated by Yamashkin et al. (Chemistry of Heterocyclic Compounds (New York)(Translation of Khimiya Geterotsiklicheskikh Soedinenii) (1999), Volume Date 1998, 34(9), 1050-1065, abstract) would be ***maintained*** for reasons of record. The compounds with the RN 243669-00-3, 243669-02-5, 243669-04-7, 243669-06-9, would still be encompassed by the instant claims wherein R₂ is CH₃.

5. The 102(b) rejection over El-Desoky (Zeitschrift fuer Naturforschung, B: Chemical Sciences (1998), 53(10), 1216-1222, abstract) would be withdrawn since the deletion of hydrogen from the definition of R₂ as in the amended claims would set a demarcation from the prior art compound.

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6. The 102(b) rejection over Majumdar et al. (Journal of Chemical Research, Synopses (1997), (9), 310-311, abstract) would be withdrawn since the deletion of hydrogen from the definition of R2 as in the amended claims would set a demarcation from the prior art compound.

7. The 102(b) rejection over Yamashkin et al. (Khimiya Geterotsiklicheskikh Soedinenii (1983), (4), 493-7, abstract) would be ***maintained*** for reasons of record. The compounds with the RN 86269-88-7, 86269-91-2 would still be encompassed by the instant claims wherein R2 is CH₃.

8. The 102 (b) rejection over Akhvlediani et al. (Zhurnal Organicheskoi Khimii (1981), 17(7), 1542-6, abstract) would be withdrawn since the deletion of hydrogen from the definition of R2 as in the amended claims would set a demarcation from the prior art compound.

9. The 103 rejection over Adams (WO 00/12502) would be withdrawn for the amended claims. Deletion of hydrogen from the definition of R2 would set a further demarcation from the example compound of Adams. Motivation to modify Adams' example compound via multiple changes to arrive at the instant would be lacking.

10. The amendment deleting C1 from C1-C8 alkyl, C1-C6 alkyl, C1-C4 alkyl in the definition of R2 would constitute new matter, since they are not described in the specification and a species falling within C2-C8 alkyl, C2-C6 alkyl, C2-C4 alkyl is not found in the specification. The court has held that 'whatever may be the viability of an inductive-deductive approach to arriving at a claimed subgenus, it cannot be said that such a subgenus is necessarily described by a genus encompassing it and a species upon which it reads.' In re Wilder, 736 F.2d 1516, 1520, 222 USPQ 369, 372 (Fed. Cir. 1984). See MPEP 2163.05.

11. The compounds of Group III in Claims 40-41, and the composition thereof, are allowable. The instant compounds having a 3-2,2,2-trifluoroethyl and a 9-trifluoromethyl are not


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taught or suggested by the prior art of record. Motivation to modify the prior art compound to arrive at the instant is lacking.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Evelyn Huang whose telephone number is 571-272-0686. The examiner can normally be reached on Tuesday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane can be reached on 571-272-0699. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Evelyn Huang
Primary Examiner
Art Unit 1625